UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/294,956	04/20/1999	INGEMAR J. COX	12558	6648

23389 7590 08/29/2006

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER	
ZAND, KAMBIZ	

ART UNIT	PAPER NUMBER
2132	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/294,956	COX ET AL.	
	Examiner	Art Unit	
	Kambiz Zand	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *RCE filed on 05/04/2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *135-205* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *135-205* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/04/2006 has been entered.

2. The text of those sections of Title 35,U.S.Code not included in this section can be found in the prior office action.

3. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

4. Claims 1-134 have been cancelled.

5. New claims 135-205 have been added.

6. Claims 135-205 are pending.

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 135-163** are rejected under 35 U.S.C. 101 because the limitations of the claims 135-163 do not disclose a tangible embodiment but only software process.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claims 135-205** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **There is no support for limitation "Global Positioning Satellite" transmission in the specification and such limitations is considers as a new matter.**

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claims 135-205** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 135 and 171 refers to "inserting a digital signature into digital data", however the cancelled claims 130-133 referred to "inserting data into digital data". The specification in summary of the invention also makes the same disclosure of cancelled claims 130-133.

Furthermore the claims 135 and 171 disclose, "signing the digital data".

It is not clear whether the signing the digital data contains signing the inserted digital signature that was earlier inserted into digital data, or the digital data before the insertion of the digital signature. It is not clear if the limitation "inserting a digital signature into digital data" in the preamble of the claims is a typo error and applicant meant to have "inserting data into digital data".

Examiner considers that as typo error for the purpose of the examination.

However a clear response or correction would expedite the examination.

Also if the limitation were a typo error on the part of the applicant, the next office action would not be another non-final rejection if the rejection will be maintained but a final rejection.

Claim Rejections - 35 USC § 103

14. **Claims 135 and 171** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauratani et al (6,061,451 A) in view of Ruppert et al. (5,640,002 A), and further in view of Perlman (5,175,765).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

As per claims 135, 137-148, 150-161, 167-171, 173-184, 186-196 and 202-205

Mauratani et al (6,061,451 A) teach a method, a device for inserting data into digital data comprising at least one of an image data content file, a video data content file and an audio data content file (see fig.19 referees to stream data and fig. 23 disclose both audio and video file; also see associated text) for subsequent authentication of the digital data (see fig.1 where the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16) , the device comprising:

An antenna for receiving data from a radio frequency transmission (see col.5, lines 20-24 where the data network received may be received from an antenna that corresponds to a radio frequency that also have antenna transmission and receiver as an inherent part of its system);

Means for inserting the data into the digital data image (see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27; also see image data such as mpeg in the entire reference; Also see col.5-28 where different embodiment using above methods and means of claims 130 and 132 are disclosed) but do not disclose explicitly receiving data comprising a public key and insertion of the received data into predetermined bits portions. However Ruppert et al. (5,640,002 A) disclose receiving data comprising a public key and insertion of the received data into predetermined bits portions (see fig. 41 where block 749 discloses sending or receiving of public key, block 751 discloses digital data consisting of serial number and store id and insertion of public key as received data into bit portions that is the encrypted digital data (encrypting using public key), and block 753,757,759 for authentication based on the received data). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ruppert's public key insertion into digital data in Mauratani's authentication based system on such insertion in order to authenticate the digital data in a secure fashion using public key crypto system.

Mauratani et al (6,061,451 A) in view of Ruppert et al. (5,640,002 A) do not disclose that the receiving data includes digital signature and the public key included. However Perlman (5,175,765 A) disclose a digital data may include digital signature including the public key (see fig.2 and associated text). Therefore it would have been obvious to utilize Perlman's digital data format that includes digital signature and public key in Mauratani's authentication based system in view of Ruppert's public

key insertion into digital data in order to control the transmission of duplicates packets (see col.2, lines 6-7).

As per claims 135, 137-148, 150-161, 167-171, 173-184, 186-196 and 202-205

Mauratani et al (6,061,451 A) teach a method, a device for inserting data into a digital image comprising at least one of an image data content file, a video data content file and an audio data content file (see fig.19 refers to stream data and fig. 23 disclose both audio and video file; also see associated text) for subsequent authentication of the digital image (see fig.1 where the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16), the device comprising:

A computer capable of accessing the Internet and receiving data from an Internet link (see col.8, lines 49-57; col.8, lines 58-63);

Means for inserting the data into the digital image (see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27; also see image data such as mpeg in the entire reference; Also see col.5-28 where different embodiment using above methods and means of claims 131 and 133 are disclosed) but do not disclose explicitly receiving data comprising a public key and insertion of the received data into predetermined bits portions. However Ruppert et al. (5,640,002 A) disclose receiving data comprising a public key and insertion of the received data into

predetermined bits portions (see fig. 41 where block 749 discloses sending or receiving of public key, block 751 discloses digital data consisting of serial number and store id and insertion of public key as received data into bit portions that is the encrypted digital data (encrypting using public key), and block 753,757,759 for authentication based on the received data). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ruppert's public key insertion into digital data and authentication based on such insertion in order to authenticate the digital data in a secure fashion using public key crypto system.

Mauratani et al (6,061,451 A) in view of Ruppert et al. (5,640,002 A) do not disclose that the receiving data includes digital signature and the public key included. However Perlman (5,175,765 A) disclose a digital data may include digital signature including the public key (see fig.2 and associated text). Therefore it would have been obvious to utilize Perlman's digital data format that includes digital signature and public key in Mauratani's authentication based system in view of Ruppert's public key insertion into digital data in order to control the transmission of duplicates packets (see col.2, lines 6-7).

Claims 136 and 172 applying hash function to a digital data is well known in the art regardless of digital data format.

Allowable Subject Matter

15. **Claims 149, 162-166, 185 and 197-201** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101; 112, Ist and 2nd paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned as (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KAMBIZ ZAND
PRIMARY EXAMINER

08/25/2006

AU 2132